

### Remarks

In reply to the Office Action dated **July 10, 2006**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group III, represented by claims 34-40, 53, 55 and 56. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. This election is made **with** traverse.

As noted in MPEP § 803, "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." The present election is made with traverse because it is believed that the search and examination of all of the claims can be made without serious burden on the part of the Examiner. The Examiner has pointed to differences in the claims and has asserted that "a keyword / literature search for the methods of invention I would not be co-extensive with a keyword / literature search for the methods invention II-IV." However, the Examiner has not explained why such differences would cause a serious burden on the part of the Examiner. Applicants submit that a search of the recited groups would sufficiently overlap with a search of the other groups due to the close relationship among the subject matter shared by the claims.

The Examiner asserted that claims 34-40, 53, 55 and 56 are "in improper Markush format." The Examiner further stated that "[t]he claims are improperly joined as the claimed methods require the analysis of distinct target molecules -- i.e., nucleic acids and proteins."

Applicants respectfully disagree with these assertions and submit that no claim amendments are required at the present time.

Applicants first note that claims 34-40, 53, 55 and 56 are not written in Markush format. As noted by the MPEP § 803.02, "A Markush-type claim recites alternatives in a format such as 'selected from the group consisting of A, B and C.' See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925)." None of the claims 34-40, 53, 55 or 56 are written to recite alternatives using language such as "selected from the group consisting of A, B and C." Since claims 34-40, 53, 55 or 56 are not written in Markush format, it follows that they are not "in improper Markush format," as asserted by the Examiner.

In addition, it is unclear why the Examiner believes that the claims are "improperly joined" or what is even meant by "improperly joined" claims. The Examiner has not pointed to any law, rule or section of the MPEP that explains the meaning of "improperly joined" claims. The Examiner simply stated that:

the claimed methods require the analysis of distinct target molecules -- i.e., nucleic acids and proteins. A reference against the analysis of one target molecule would not necessarily constitute a reference against the other target molecule.

Applicants are not aware of any legal requirement or requirement in the MPEP for the claims in a patent application to be written such that a reference against one embodiment encompassed by the claim necessarily constitutes a reference against another embodiment encompassed by the claim. Applicants respectfully submit that, according to the Examiner's reasoning, all generic claims would be *per se* improper simply because they encompass a genus of embodiments of the invention. Clearly, there is no such requirement.

The Examiner also asserted that "the claims do not recite proper species," and that "Applicants are required to amend the claims to set forth only the elected inventive groups."

The Examiner, however, has not explained why it is believed that the claims do not recite proper species. Applicants also believe that it is premature to require amendments to the claims, especially since the Restriction Requirement has not yet been made final. Applicants will consider appropriate claim amendments when and if the Restriction Requirement is made final.

### **Conclusion**

In view of the foregoing comments, Applicants respectfully request that the outstanding Restriction Requirement be reconsidered and withdrawn.

Consideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

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